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09/735,721	12/13/2000	Louis Brown Abrams	D. N. 7218	4531

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EXAMINER

JUSKA, CHERYL ANN

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 10/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,721

Applicant(s)

ABRAMS, LOUIS BROWN

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 16-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 16-18, 25-31, and 38-49 is/are rejected.
- 7) ☒ Claim(s) 19-24 and 32-37 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/25/03-05/09/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on November 26, 2003, has been entered.

Response to Amendment

2. Applicant's amendments filed November 26, 2003 and February 24, 2004 have been entered. Claims 3-15 are cancelled and new claims 48 and 49. Thus, the currently pending claims are 1, 2, and 16-49.

3. With applicant's filing of an RCE, the case was petitioned to be withdrawn from issue. Said petition was granted on December 2, 2003. Thus, prosecution is reopened and the previously indicated allowable subject matter is hereby withdrawn in view of the following new rejections.

Specification

4. The amendment filed January 8, 2003, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. Specifically, the sentence added at the end of the paragraph on page 7, line 24, is considered new matter: "As shown in FIG. 3, a fringe material 50 can be applied to peripheral edges of the flocked release sheet 1 or substrate 15 during this manufacturing process." First, it is noted that the drawings as originally filed do not identify "fringe material 50." Secondly, the specification as originally filed never discusses any fringe material. Thirdly, it is not clear from FIG. 3 or the amended FIG 3 (filed February 25, 2003) that the item identified as "50" is indeed a "fringe material." While FIG. 3 *may* show a "fringe material," without any recitation in the specification to fringe, FIG. 3 can also be interpreted as an exaggerated view of the edges of flocked surface of the transfer 1. As such, the amendment to the specification reciting a "fringe material" is considered new matter. Fourthly, even if it is conceded that FIG. 3 as originally filed is sufficient support for "fringe material 50," the specification lacks support for the embodiment that said fringe material is applied to the peripheral edges of substrate 15. Therefore, said amendment to the specification is considered new matter. Applicant is required to cancel the new matter in the reply to this Office Action.

Drawings

5. The drawing of FIG. 3, filed February 25, 2003, is not accepted by the Examiner in that the amended drawing contains new matter as discussed above.

Claim Rejections - 35 USC § 112

6. Claims 41, 43, and 45 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.
7. Claim 43 contains new matter in that the phrase “comprising a fringe material extending outwardly from peripheral edges of the substrate” is not supported by the specification as originally filed. Claim 45 is similarly rejected.
8. Claim 41 contains new matter because the specification does not clearly support the limitation that “at least most” of an adjacent surface of the transfer is in direct physical contact with the thermosetting film.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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10. Claims 1, 16, 26, 27, 29, 39, 40, 46, 48, and 49 are rejected under 35 USC 103(a) as being unpatentable over US 4,687,527 issued to Higashiguchi in view of US 4,810,549 issued to Abrams et al.

Higashiguchi teaches it is known in the art to produce flock transfers comprising a release paper having a weak adhesive thereon to which fibers are flocked (col. 1, lines 24-26). A hot melt adhesive is then applied to the tips of the flock in a predetermined pattern (col. 1, lines 27-31). Said flock transfer is then applied to the surface of a fabric substrate and said flock is transferred upon application of heat and pressure (col. 1, lines 31-35).

Thus, Higashiguchi teaches the invention of claims 1, 16, 26, 27, 29, 39, 40, 46, 48, and 49 with the exception that the flock is arranged on the release sheet in a desired pattern. While Higashiguchi employs a solidly flocked transfer sheet and patterns the hot melt adhesive to create the flock pattern, it would have been readily obvious to one of ordinary skill in the art to reverse the process. For example, it is well known in the art to produce a flock transfer sheet having a desired flock pattern thereon. Note Abrams, col. 2, lines 34-43. Thus, it would have been obvious to one of ordinary skill in the art to create the flock pattern on the transfer sheet rather than with the patterned hot melt adhesive as taught by Higashiguchi. Such a modification would enable less flock waste on the flock transfer. Therefore, claims 1, 16, 26, 27, 29, 39, 40, 46, 48, and 49 are rejected.

Regarding claims 2, 18, 25, 28, and 38, which limit the thermoplastic hot melt sheet to a blank or a preformed film before application to the flock and substrate, the cited prior art renders the claims obvious. Said limitation reflects the method of making the flock transfer assembly. As such, said limitation is not necessarily given patentable weight at this time since the claims

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are examined on the structure of the final product. It is asserted that the final product of the prior art has the same structural features of the present invention as described in the preceding paragraph. Therefore, claims 2, 18, 25, 28, and 38 are also rejected.

Claim 31 is similarly rejected in that the method step of pre-cutting the thermoplastic hot melt sheet is not necessarily given patentable weight at this time. Thus, claim 31 is also rejected as being obvious over the cited prior art.

With respect to claims 41 and 47, it is argued that the limitation that at least most of the surface of the transfer is in direct contact with the thermoplastic hot melt is met by the fact that the amount of surface contact is dependent upon the desired pattern. As such, it would have been readily obvious to one skilled in the art to maximize the surface contact in order to produce less waste of the flock transfer. Therefore, claims 41 and 47 are also rejected.

Regarding claims 17, 30, 42, and 44, while the cited prior art fails to teach the thermoplastic hot melt is polyurethane or a rubber substrate, it would have been obvious to one of ordinary skill in the art to select a polyurethane hot melt or substitute a rubber substrate for the fabric substrate since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. *In re Leshin*, 125 USPQ 416. Therefore, claims 17, 30, 42 and 44 are also rejected.

11. Claims 43 and 45 are rejected under 35 USC 103(a) as being unpatentable over the cited Higashiguchi and Abrams references and in further view of “*When is a mouse pad really a rug?*” by R. Landwehr.

While Higashiguchi and Abrams fail to explicitly teach the use of fringe on the edge of the flock transfer, said fringe is known in the art of flocked articles. For example, the Landwehr

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article teaches a flocked mouse pad having a design of an oriental rug, including having fringed edges. Therefore, it would have been obvious to one skilled in the art to employ fringe edges for decorative purposes. Thus, claims 43 and 45 are rejected as being obvious over the cited prior art.

Allowable Subject Matter


12. Claims 19-24 and 32-37 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. While the prior art teaches the flock transfers of claims 1 and 26, said prior art does not teach or fairly suggest that the thermoplastic hot melt sheet comprises two parts that differ in properties. Therefore, claims 19-24 and 32-37 contain allowable subject matter.

Conclusion

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER

cj
October 1, 2005